

REMARKS/ARGUMENTS

Claims 1-13 are pending in the present application after this amendment cancels claims 14-37. The amendments do not add new matter and find support throughout the specification and figures.

In view of the Examiner's earlier restriction requirement, Applicant retains the right to present claims 14-36 in a divisional application. Claims 1-13 stand rejected under 35 U.S.C. § 103(a). It is respectfully submitted that all of the presently pending claims are allowable for at least the following reasons.

35 U.S.C. § 103(a)

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,368,658 to Schwarz et al. (the Schwarz reference) in view of United States Patent Publication No. 2003/0230819 to Park et al. (the Park reference). Applicant respectfully submits that claims 1-13 are in condition for allowance, for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Independent claim 1 relates to a method for coating a medical appliance that includes, among other things, suspending the at least one medical appliance in a fluidizing gas flow and directing a coating onto an ultrasonic nozzle. The ultrasonic nozzle is directed towards the medical appliance. The method according to claim 1 also includes vibrating the ultrasonic nozzle at a rate sufficient to atomize the coating.

Although the Examiner admits that the Schwarz reference fails to teach the use of an ultrasonic nozzle to coat a medical appliance (Office Action; page 5, ll. 1-3), the Examiner asserts that this feature is taught by the Park reference.

It is respectfully submitted that there is no suggestion in the prior art to modify the Schwarz reference in view of the Park reference in order to arrive at the invention of claim 1. The Examiner asserts that it would have been obvious to employ in the Schwarz reference the

teaching of the Park reference. However, the Schwarz reference apparently relates to a coating method using air suspension. The Schwarz reference gives no suggestion of the usefulness of a combination with the ultrasonic atomizer apparently discussed in the Park reference. The Schwarz reference apparently discusses the use of low velocity air streams, but does not discuss, or even suggest, the use of an ultrasonic nozzle. Furthermore, the Schwarz reference apparently discusses low velocity nozzles in the context of injecting the coating material into a chamber (Schwarz; col. 9, ll. 8-11), but does not discuss atomizing a coating material with a low-velocity nozzle, nor more particularly, atomizing a coating material using an ultrasonic nozzle. The Schwarz reference does not express any problem or unmet need that would motivate a practitioner to use an ultrasonic nozzle in combination with the method and apparatus of the Schwarz reference.

Similarly, the Park reference provides no motivation to combine the ultrasonic atomizer of the Park reference with the air suspension method of the Schwarz reference. The Park reference does apparently discuss coating stents, but does not discuss, or even suggest coating stents using an air suspension method, as apparently discussed in the Schwarz reference. The only motivation to combine the references comes from the disclosure of the Applicant, which constitutes improper hindsight reasoning. Since there is no motivation or suggestion to combine the references, the references do not render the subject matter of claim 1 obvious.

The Examiner's response to the argument presented above restates the purported motivation for combining the references. However, the Examiner asserts that the motivation to combine the references arises from the desire for controlled release. (Office Action; page 3, ll. 11-14). However, the controlled release of the Park reference apparently results from microencapsulation of droplets or the polymer used in the coating. (Park; Abstract). The microencapsulated droplets of the Park reference provide controlled release in the same manner envisioned by the Schwarz reference, namely through the qualities of the polymer, and therefore controlled release does not provide a motivation to combine the references. The layer of microcapsules apparently provided in the Park reference (Park; para. 130) does not provide any improvement in controlled release over the method of polymer diffusion apparently discussed in the Schwarz reference (Schwarz; col. 7, ll. 2-14), and therefore does not provide a motivation to combine the references. Furthermore, the allegation that one skilled in the art would recognize that the method according to the Park reference would provide coating improvements including minimal defects is unsupported. Applicants respectfully request a citation in support of this assertion, or alternatively, that the rejection be withdrawn.

Claims 2-13 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Furthermore, claim 3 includes the operation of directing the fluidizing gas flow at the ultrasonic nozzle. The fluidizing gas flow of claim 3 transports the atomized coating to the at least one medical appliance. It is respectfully submitted that neither the Schwarz reference nor the Park reference discloses, or even suggests, this feature. The Schwarz reference apparently discusses using multiple nozzles, and apparently discusses using low-velocity nozzles to inject coating into a chamber (Schwarz; col. 9, ll. 8-11), but the Schwarz reference does not suggest using the fluidizing gas flow to transport atomized coating to the appliance. In particular, the Schwarz reference teaches away from using a high pressure jet to transport the atomized coating when it states that "[a]ny other nozzles may be only used to inject the coating material(s) into the chamber 120 at a low velocity so as not to disrupt the cyclical flow of air and medical devices." (Schwarz; col. 9, ll. 8-11). As discussed above, the Park reference does not discuss an air suspension method at all.

The Examiner's response to this argument cites a section of the Schwarz reference which apparently discusses introducing coating material into the air suspension system. (Schwarz; col. 2, ll. 1-8). However, there is no indication in the Schwarz reference of *directing the fluidizing gas flow at* the ultrasonic nozzle, as recited in claim 3. Therefore, since none of the references discuss, or even suggest, this feature, the combination of the references does not render claim 3 unpatentable. It is therefore respectfully submitted that claim 3 is in condition for allowance.

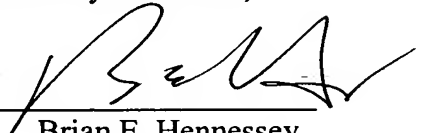
For at least the reasons discussed above, withdrawal of the rejections under 35 U.S.C. §103(a) with respect to claims 1-13 is hereby respectfully requested.

CONCLUSION

Applicant respectfully submits that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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